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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/678,616

10/06/2003

Joseph Edward Currie

9441

34606

7590

12/07/2005

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EXAMINER

MULLEN, THOMAS J

ART UNIT

PAPER NUMBER

2632

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/678,616	Applicant(s) CURRIE, JOSEPH EDWARD	
	Examiner Thomas J. Mullen, Jr.	Art Unit 2632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-10 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input checked="" type="checkbox"/> Other: <u>Appendix (20 pages)</u> . |

Art Unit: 2632

1. Regarding the preliminary amendment filed 1/20/04, the replacement drawing sheets are acceptable; however, the substitute pages 5-10 for the specification are not in compliance with 37 CFR 1.121 ("Manner of Making Amendments", see attached Appendix) and thus cannot be entered. In particular, changes made to particular paragraphs, or section headings, of the specification need to be made by submitting replacement paragraphs or replacement section headings (whose starting point in the original specification needs to be identified by page and line number), having the changes shown by underlining the insertions and lining through the deletions. Thus, the intended changes on pages 5-10 need to be submitted in the form of replacement paragraphs, in the format just discussed.

2. The disclosure is objected to because of the following informalities:

paragraph 03, line 4, it appears that "manufactures" should be --manufacturers--;

at the top of page 2 of the specification, it appears that the paragraph number "03" should instead be --04--;

paragraph 04 (as renumbered above), it appears that the patent number in part "c." should be 6,486,774 instead of 6,486,744;

paragraph 05, line 2, it appears that "implies" should be --imply--;

paragraph 07, line 10, it appears that "decreases" should be --decrease--;

paragraph 07, line 14, it appears that "decrease" should be --decreases--;

paragraph 15, line 3, it appears that "break" should be --brake--;

paragraph 15, lines 9 and 11, it appears that "bard" (one occurrence on each line) should be --bar--;

paragraph 15, line 15, "herein after" should be one word;

paragraph 15, line 16, "LEDS" should be --LEDs--;

paragraph 15, line 19, it appears that "pin 4" should be --pin 1-- (i.e., in Fig. 1B, there appear to be ten (10) driver outputs at pins 1 and 10-18, of which pin 1 corresponds to "LEDs 20 A&B");

paragraph 16, line 1, it appears that "break" should be --brake--;

paragraph 16, last line, "LEDS" should be --LEDs--;

paragraph 17, line 6, "though" should be --through--;

paragraph 17, line 14, "In put" should be one word; and
paragraph 22, line 1, it appears that "invented" should be deleted, as this term is vague in terms of further defining the phrase "inverse function illuminating power meter 82".

Appropriate correction is required.

3. The drawings are objected to because:

near the left edge of Figs. 1B and 2C, it appears that "Break" should be --Brake--;
near the left edge of Fig. 2D, "Voltag" should be --Voltage--; and
at the lower left portion of Fig. 2A, the symbol for an LED which is associated with identifier "D1A" is superimposed on the black dot signifying an electrical connection, rather than appearing below (and being connected to) the black dot.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following elements must be shown or the feature(s) canceled from the claim(s):

"translucent plastic cover, or combination cover and lens, to diffuse and defocus light from the segmented light sources" (claim 3, part (f));

"a normally closed relay contact" which is connected to "a vehicle cruise control" device and/or "cruise hold speed" selector (claim 5);

"segmented display...in the form of concentric circular segments" (claim 6); and

"dual colored light emitting diodes" (claims 8 and 10), and associated "electrical switch means" (claim 10).

No new matter should be entered.

5. As to paragraphs 3-4 above, corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet"

Art Unit: 2632

or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. Claims 2-6, 8 and 10 are objected to under 37 CFR 1.75(c), which states in part that "(c)laims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim". In this case, for example, claims 2-3 are directed only to a "segmented illuminating display of claim 1" (claim 3 also refers to "the electronic circuit of claim 1"), which is merely one element of claim 1 that overall is directed to an "illuminating device that combines (various indications)", see lines 1-2 of claim 1, from which it is unclear whether or not claims 2-3 include all the limitations of claim 1. Likewise, claim 6 is merely directed to the "illumination means" of claim 1 (part (a)), rather than the overall "illuminating device" of claim 1; claims 4, 5 and 10 are merely directed to the "electronic circuit means" of claim 1 (claim 4 also refers to "the segmented illuminating display of claim 1", and it is noted that claim 10 depends from claim 6, mentioned above, which in turn depends from claim 1); and claim 8 is merely directed to the "segmented illuminating display" of claim 7.

In general, a dependent claim should refer back to the claim from which it depends only once, preferably at the beginning of the claim, rather than using multiple phrases of the type, "the (device) according to claim 1" at different points in the claim.

7. Claims 1-10 are objected to under 37 CFR 1.75(a) for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 11, "said electronic circuit" lacks clear antecedent basis (note "electronic circuit means", line 10).

Claim 1, third line from bottom, "dc" should be --DC--, to be consistent with the other uses of "DC" as an abbreviation for "direct current".

Claim 2, line 1, after "where" the semi-colon should be replaced with a colon or a comma.

Claim 2, lines 5, 10 and 12, "break" (one occurrence on each line) should be --brake--.

Claim 7, line 3, "said engine power level indicating means" lacks clear antecedent basis.

Art Unit: 2632

Claim 7, the occurrence of "said electronic circuit" in each of parts (b)-(f) lacks clear antecedent basis (note "electronic circuit means" in part (b)).

Claim 8, line 7, "mores" should be --more--.

Claim 8, line 10, "horizontal" should be --horizontally--.

Claim 9, line 6, "said selected maximum engine power value" lacks clear antecedent basis.

Claim 9, line 7, after "comprising" the semi-colon should be replaced with a colon or a comma.

Claim 10, "the dual colored light-emitting diodes" lacks antecedent basis; it appears that claim 10 should have depended from claim 8, rather than claim 6.

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the LEDs being "dual colored" and having a corresponding "electrical switch means" (see claims 8 and 10), the segmented display being in the form of "concentric circular segments" (see claim 6), and the segmented light sources having "a translucent plastic cover, or combination cover and lens" (see claim 3), should be explained in the specification and depicted in some manner in the drawings (see paragraph 4 above), or else deleted from the claims. (It is noted that paragraph 7 of the specification mentions using a "circular" segmented display, but there is no mention of circular segments being "concentric", nor is there any showing of this embodiment in the drawings.)

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 2, 5 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described

Art Unit: 2632

in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The application fails to provide an enabling disclosure for an embodiment having the features recited in claim 2, part(b), where an engine power level indication and a brake light indication (as in the embodiment of Fig. 1) can comprise "two or more rows" of horizontally disposed illuminating segments, either in the case "where both rows of illuminating elements may function as both an engine power display and as a (brake) light", or in the case where one row is for the engine power level and the other row is for the brake light.

The application fails to provide an enabling disclosure for an embodiment having the features recited in claim 5, where "a normally closed relay contact...is operated to the open condition whenever...a vehicle cruise control is operated...and a cruise hold speed has been selected". There appears to be no mention in the specification, or any showing in the drawings, of elements relating to a "cruise control" device of a vehicle.

The application fails to provide an enabling disclosure for an embodiment having the features recited in claim 8, part (f), where a row of illuminating elements is "dedicated to a park light and a brake light function"; the only combinations of "functions" disclosed as being associated with a single "row" of illuminating elements are those recited in parts (b) and (c) of claim 8.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 2-5, 7-8 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 contains alternate recitations (parts (a) and (b) of the claim, respectively) regarding the arrangement of the "display", whereby the scope of the claim cannot be determined, as it is unclear which display arrangement is intended to further limit the claim.

Art Unit: 2632

In claim 3, line 19 and at the beginning of claim 10, "the (or "The") electronic circuit" lacks antecedent basis (note "electronic circuit means", claim 1), and where claim 1 recites multiple "electronic circuit means" (on lines 10 and 16, respectively), it is unclear which such "means" is being referred to. (Regarding the following phrase "of claim 1" on line 19 of claim 3, see paragraph 5 above.)

In claim 4, it is unclear what difference, if any, is intended between "approximately normal brake light intensity" (lines 3-4) and "full brake light intensity" (line 7).

At the beginning of claims 4-5, "The electronic circuit means" is indefinite since, where claim 1 recites multiple "electronic circuit means" (on lines 10 and 16, respectively), it is unclear which such "means" is being referred to. (Note the further discussion of these portions of claims 4-5, in paragraph 5 above.)

In claim 7, lines 8-9, it is unclear whether "the power level function" and "the power display function" refer to the same thing, and the relationship between these terms and the "means for indicating variable engine power" (lines 1-2) is unclear.

In claim 7, it is unclear if the "illumination means" recited on line 10 refers to the same or different element as the "illuminating means" recited on line 1.

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elliott (US 6753769) in view of Tonkin et al (US 5856793).

(Note: the effective date of Elliott is no later than 6/10/02.)

Claim 9

Note in Elliott, segmented illuminating display comprising lamp pairs 12-22 (Figs. 3a and 7), mounted at the rear of a vehicle (Figs. 1-2) and "energized in a sequence" based on a predetermined acceleration-related condition of the vehicle (see the Abstract, and the Table in

col. 3, starting with the second item in the Table), i.e. "depending on the position of the brake (28) and accelerator (24) pedals" (note the various "switching devices" or "sensing systems" shown in Figs. 3A-6B). In particular, the Table in col. 3 of Elliott teaches that "the amount of illumination...increases as a function of decreasing (acceleration-related signals), and decreases as a function of increasing (acceleration-related signals), with a "maximum" and a "minimum" illumination as recited in the claim; the outputs of the "switching devices" or "sensing systems" of Elliott inherently represent a "function of decreasing/increasing engine power". In one embodiment, Elliott teaches monitoring the position of the "throttle" rather than the position of the accelerator pedal (see col. 4, lines 12-35, and Fig. 8), wherein the throttle--generally represented by element 90 in Fig. 8--has its own "electromechanical (position) sensor" (note block 92 in Fig. 8); control circuit 98 responds to the throttle position sensor (along with possibly other inputs) to "indicate the position of the throttle...(by) provid(ing) electrical signals (over) leads 108 to energize the lamps (12-22)". Control circuit 98 implicitly includes, or is connected to, "electronic switching means" to control the illuminating "sequence" of the display segments 12-22 according to the Table of col. 3, which "sequence"--in the embodiment where a throttle position sensor is included as discussed above--is implicitly controlled "as an inverse function of a DC analog voltage from (the) throttle position sensor", as claimed.

Thus, Elliott teaches all the subject matter of claim 9, except for segmented display providing "no illumination above (a) selected maximum engine power value", e.g. when the vehicle has at least a predetermined positive acceleration. However, it would have been obvious to incorporate within the Table of col. 3 in Elliott (and thus into the overall disclosed "signaling system"), a condition wherein no illumination is provided--i.e., where no particular signal needs to be communicated to the driver of a following vehicle. For example, Tonkin et al discloses a similar system (see the Abstract and col. 3, lines 6-64) wherein a segmented illumination array comprises pairs of lights 10-17 (see Figs. 1-3) which pairs are sequentially illuminated responsive to increasing degrees of deceleration, starting with pair 10,11--the centrally-positioned pair--which is illuminated responsive to "gentle deceleration" (col. 3, lines 35-36), implying that no illumination occurs when the vehicle is not decelerating (corresponding to the engine being above a selected "power value"). One skilled in the art would have recognized that providing a "no illumination"-state in the segmented display of Elliott, when the engine is above

Art Unit: 2632

a selected "power value", would have avoided provided unnecessary or irritating "signals" to following drivers in the situation where no particular danger of a collision is present. Therefore, in view of Tonkin et al it would have been obvious to incorporate a "no illumination"-state in the segmented display of Elliott, as claimed.

Claim 1

Claim 1 additionally recites providing a "brake light indication" using the same "illuminating device", such that the brake light indication function has "priority" over the engine power level indication function, and electronic circuit adjustment means for the "voltage range" defining the selectable maximum and minimum "engine power" levels for the power level indications. Both Elliott and Tonkin et al teach using at least part of the illumination device as "brake lights" as well as engine power lights; note the above discussion regarding Elliott, and brake switch 80 in Tonkin et al. Tonkin et al further teaches that the brake light function may have "priority" over the engine power function, as implied at col. 4, lines 10-15 in Tonkin et al (wherein centrally-located lights 10,11 are illuminated when the brake pedal is depressed, "independent of the actual deceleration caused", as an "initial" indication). Also, Tonkin et al provides an "electronic circuit means" 52 for adjusting the voltage input parameter associated with a given vehicle deceleration (see col. 6, lines 7-15), in effect controlling the upper and lower bounds of the acceleration range monitored. Thus, it would have been obvious to combine the teachings of Elliott and Tonkin et al to arrive at the "device" recited in claim 1, for reasons discussed above.

15. Claims 7-8 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st and/or 2nd paragraphs, and objection(s) under 37 CFR 1.75(a), set forth in this Office action.

Claims 2-6 and 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st and/or 2nd paragraphs, and objections under 37 CFR 1.75(a), set forth in this Office action, and to include all of the limitations of the base claim and any intervening claims.

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2632


The art discussed by applicant in the specification has been considered. Lariscy (US 4924207), Bryant (US 3638181) and Perry (US 2734105) disclose various vehicle rear-mounted illumination devices responsive (at least in part) to a throttle position sensor. Asano et al (US 5629669), Jeon (US 6356833) and Paulo (US 6675650) disclose various vehicle "dashboard"-mounted alert means responsive (at least in part) to a throttle position sensor. Ishikawa et al (US 5463370) discloses various forms of segmented illumination devices mounted at the rear of a vehicle. Salsman (US 5089805), Matsumoto (US 6150933), Jacobs (US 3748643), UK publications 2382404 and 2258531, and German publication 4035185 are cited to further show the state of the art.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Mullen, Jr. whose telephone number is 571-272-2965. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu, can be reached on (571) 272-2964. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

TJM



Thomas J. Mullen, Jr.
Primary Examiner
Art Unit 2632

Appendix

1. If applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form may be required. While an application can be amended to make it clearly understandable, no subject matter (new matter) can be added that was not disclosed in the application as originally filed.

2. Following are the copies of § 37 CFR 1.71 (Detailed description and specification of the invention), § 37 CFR 1.75 (Claims), § 37 CFR 1.111 (Reply by applicant or patent owner to a non-final Office action), § 37 CFR 1.112 (Reconsideration before final action), § 37 CFR 1.113 (Final rejection or action), § 1.121 (Manner of making amendments in application); § 37 CFR 1.125 (Substitute specification), and § 37 CFR 1.126 (Numbering of Claims) are provided below regarding the proper format and contents of an application and its amendments:

§ 1.71 Detailed description and specification of the invention.

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

(d) A copyright or mask work notice may be placed in a design or utility patent application adjacent to copyright and mask work material contained therein. The notice may appear at any appropriate portion of the patent application disclosure. For notices in drawings, see § 1.84(s). The content of the notice must be limited to only those elements provided for by law. For example, “©1983 John Doe”(17 U.S.C. 401) and “*M* John Doe” (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in paragraph (e) of this section is included at the beginning (preferably as the first paragraph) of the specification.

(e) The authorization shall read as follows:

A portion of the disclosure of this patent document contains material which is subject to (copyright or mask work) protection. The (copyright or mask work) owner has no objection to the facsimile reproduction by any-one of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records, but otherwise reserves all (copyright or mask work) rights whatsoever.

(f) The specification must commence on a separate sheet. Each sheet including part of the specification may not include other parts of the application or other information. The claim(s), abstract and sequence listing (if any) should not be included on a sheet including any other part of the application.

[paras. (d) and (e), 53 FR 47808, Nov. 28, 1988, effective Jan. 1, 1989; para. (d), 58 FR 38719, July 20, 1993, effective Oct. 1, 1993; para. (f) added, 68 FR 38611, June 30, 2003, effective July 30, 2003]

§ 1.75 Claim(s)

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

(b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.

(c) One or more claims may be presented in dependent form, referring back to and

further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim ("multiple dependent claim") shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. For fee calculation purposes under § 1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein. For fee calculation purposes, also, any claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim. In addition to the other filing fees, any original application which is filed with, or is amended to include, multiple dependent claims must have paid therein the fee set forth in § 1.16(d). Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.

(d)

(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a)).

(2) See § § 1.141 to 1.146 as to claiming different inventions in one application.

(e) Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order:

(1) A preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known,

(2) A phrase such as "wherein the improvement comprises," and

(3) Those elements, steps, and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

(f) If there are several claims, they shall be numbered consecutively in Arabic numerals.

(g) The least restrictive claim should be presented as claim number 1, and all dependent claims should be grouped together with the claim or claims to which they refer to the extent

practicable.

(h) The claim or claims must commence on a separate physical sheet or electronic page. Any sheet including a claim or portion of a claim may not contain any other parts of the application or other material.

(i) Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.

[31 FR 12922, Oct. 4, 1966; 36 FR 12690, July 3, 1971; 37 FR 21995, Oct. 18, 1972; 43 FR 4015, Jan. 31, 1978; para. (c), 47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; para. (g) amended, paras. (h) and (i) added, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (h) revised, 68 FR 38611, June 30, 2003, effective July 30, 2003; para. (h) revised, 68 FR 38611, June 30, 2003, effective July 30, 2003]

§ 1.111 Reply by applicant or patent owner to a non-final Office action.

(a)

(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§ 1.135 and 1.136 for time for reply to avoid abandonment.

(2) A second (or subsequent) supplemental reply will be entered unless disapproved by the Director. A second (or subsequent) supplemental reply may be disapproved if the second (or subsequent) supplemental reply unduly interferes with an Office action being prepared in response to the previous reply. Factors that will be considered in disapproving a second (or subsequent) supplemental reply include:

(i) The state of preparation of an Office action responsive to the previous reply as of the date of receipt (§ 1.6) of the second (or subsequent) supplemental reply by the Office; and

(ii) The nature of any changes to the specification or claims that would result from entry of the second (or subsequent) supplemental reply.

(b) In order to be entitled to reconsideration or further examination, the applicant or patent

owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the Examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.

[46 FR 29182, May 29, 1981; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(2) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 1.112 Reconsideration before final action.

After reply by applicant or patent owner (§ 1.111 or § 1.945) to a non-final action and any comments by an inter partes reexamination requester (§ 1.947), the application or the patent under reexamination will be reconsidered and again examined. The applicant, or in the case of a reexamination proceeding the patent owner and any third party requester, will be notified if claims are rejected, objections or requirements made, or decisions favorable to patentability are made, in the same manner as after the first examination (§ 1.104). Applicant or patent owner may reply to such Office action in the same manner provided in § 1.111 or § 1.945, with or without

amendment, unless such Office action indicates that it is made final (§ 1.113) or an appeal (§ 1.191) has been taken (§ 1.116), or in an inter partes reexamination, that it is an action closing prosecution (§ 1.949) or a right of appeal notice (§ 1.953).

[46 FR 29182, May 29, 1981; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.113 Final rejection or action.

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicants, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

[24 FR 10332, Dec. 22, 1959; 46 FR 29182, May 29, 1981; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); para. (a) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 1.121 Manner of making amendments in application.

(a) Amendments in applications, other than reissue applications. Amendments in applications,

other than reissue applications, are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

(b) **Specification** . Amendments to the specification, other than the claims, computer listings (§ 1.96) and sequence listings (§ 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification, in the manner specified in this section.

(1) **Amendment to delete, replace, or add a paragraph** . Amendments to the specification, including amendment to a section heading or the title of the invention which are considered for amendment purposes to be an amendment of a paragraph, must be made by submitting:

(i) An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a paragraph with one or more replacement paragraphs, or add one or more paragraphs;

(ii) The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strikethrough cannot be easily perceived;

(iii) The full text of any added paragraphs without any underlining; and;

(iv) The text of a paragraph to be deleted must not be presented with strike-through or placed within double brackets. The instruction to delete may identify a paragraph by its paragraph number or include a few words from the beginning, and end, of the paragraph, if needed for paragraph identification purposes.

(2) **Amendment by replacement section** . If the sections of the specification contain section headings as provided in § 1.77(b), § 1.154(b), or § 1.163(c), amendments to the specification, other than the claims, may be made by submitting:

(i) A reference to the section heading along with an instruction, which unambiguously identifies the location, to delete that section of the specification and to replace

such deleted section with a replacement section; and;

(ii) A replacement section with markings to show all changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived.

(3) Amendment by substitute specification . The specification, other than the claims, may also be amended by submitting::

(i) An instruction to replace the specification; and

(ii) A substitute specification in compliance with §§ 1.125(b) and (c).

(4) Reinstatement of previously deleted paragraph or section . A previously deleted paragraph or section may be reinstated only by a subsequent amendment adding the previously deleted paragraph or section.

(5) Presentation in subsequent amendment document . Once a paragraph or section is amended in a first amendment document, the paragraph or section shall not be represented in a subsequent amendment document unless it is amended again or a substitute specification is provided.

(c) Claims . Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) Claim listing. All of the claims presented in a claim listing shall be presented in

ascending numerical order. Consecutive claims having the same status of “canceled” or “not entered” may be aggregated into one statement (e.g., Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) When claim text with markings is required. All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of “currently amended,” and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of “currently amended,” or “withdrawn” if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as “withdrawn—currently amended.”

(3) When claim text in clean version is required. The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of “original,” “withdrawn” or “previously presented” will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of “withdrawn” or “previously presented.” Any claim added by amendment must be indicated with the status of “new” and presented in clean version, i.e., without any underlining.

(4) When claim text shall not be presented; canceling a claim.

(i) No claim text shall be presented for any claim in the claim listing with the status of “canceled” or “not entered.”

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as “canceled” will constitute an instruction to cancel the claim.

(5) **Reinstatement of previously canceled claim.** A claim which was previously canceled may be reinstated only by adding the claim as a “new” claim with a new claim number.

(d) **Drawings.** One or more application drawings shall be amended in the following manner: Any changes to an application drawing must be in compliance with § 1.84 and must be submitted on a replacement sheet of drawings which shall be an attachment to the amendment document and, in the header, labeled “Replacement Sheet.” Any replacement sheet of drawings shall include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. All changes to the drawing(s) shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper.

(1) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as “Annotated Marked-up Drawings” and must be presented in the amendment or remarks section that explains the change to the drawings.

(2) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(e) **Disclosure consistency.** The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(f) **No new matter.** No amendment may introduce new matter into the disclosure of an application.

(g) **Exception for examiner’s amendments.** Changes to the specification, including the claims, of an application made by the Office in an examiner’s amendment may be made by specific instructions to insert or delete subject matter set forth in the examiner’s amendment by identifying the precise point in the specification or the claim(s) where the insertion or deletion is to be made. Compliance with paragraphs (b)(1), (b)(2), or (c) of this section is not required.

(h) **Amendment sections.** Each section of an amendment document (e.g., amendment to the claims, amendment to the specification, replacement drawings, and remarks) must begin on a separate sheet.

(i) **Amendments in reissue applications.** Any amendment to the description and claims in

reissue applications must be made in accordance with § 1.173.

(j) Amendments in reexamination proceedings. Any proposed amendment to the description and claims in patents involved in reexamination proceedings must be made in accordance with § 1.530.

(k) Amendments in provisional applications. Amendments in provisional applications are not usually made. If an amendment is made to a provisional application, however, it must comply with the provisions of this section. Any amendments to a provisional application shall be placed in the provisional application file but may not be entered.

[32 FR 13583, Sept. 28, 1967; 46 FR 29183, May 29, 1981; para. (e), 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (i) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 68 FR 38611, June 30, 2003, effective July 30, 2003]

§ 1.125 Substitute specification.

(a) If the number or nature of the amendments or the legibility of the application papers renders it difficult to consider the application, or to arrange the papers for printing or copying, the Office may require the entire specification, including the claims, or any part thereof, be rewritten.

(b) Subject to § 1.312, a substitute specification, excluding the claims, may be filed at any point up to payment of the issue fee if it is accompanied by a statement that the substitute specification includes no new matter.

(c) A substitute specification submitted under this section must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown pursuant to this paragraph.

(d) A substitute specification under this section is not permitted in a reissue application or in a reexamination proceeding.

[48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (b)(2) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (b) and (c) revised, 68 FR 38611, June 30, 2003, effective July 30, 2003]

§ 1.126 Numbering of claims.

The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled the remaining claims must not be renumbered. When claims are added, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

[32 FR 13583, Sept. 28, 1967; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

3. It would be of great assistance to the Office if all incoming papers pertaining to a filed application carried the following items:

1. Serial number (checked for accuracy).
2. Group art unit number (copied from filing receipt or most recent Office Action).
3. Filing date.
4. Name of the examiner who prepared the most recent Office action.
5. Title of invention.

4. It is called to applicant's attention that if a communication is mailed before the response time has expired applicant may submit the response with a "Certificate of Mailing" which merely asserts that the response is being mailed on a given date. So mailed, before the period for response has lapsed, the response is considered timely. A suggested format for a certificate follows.

AI hereby certify that this correspondence is being deposited with the United States Postal

Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks,
Washington, D.C. 20231, on..."

Name of applicant, assignee, or Registered Representative

Signature _____

Date _____

5. The applicant is reminded that copies of U.S. patents have been provided with this Office
Action as examples for proper application format.

SAMPLE FORMAT FOR REVISED AMENDMENT PRACTICE

(Rev. 6/03)

Appl. No. : XX/YYY,YYY Confirmation No. WXYZ
Applicant : James Q. Inventor
Filed : April 19, 2003
TC/A.U. : 1744
Examiner : John Doe
Docket No. : 12345/JAS/R758
Customer No. : 88888

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

AMENDMENT

Sir:

In response to the Office action of October 16, 2003, please amend the above-identified application as follows:

Amendments to the Specification begin on page 2 of this paper.

Amendments to the Claims are reflected in the listing of claims which begins on page 3 of this paper.

Amendments to the Drawings begin on page 4 of this paper and include both an attached replacement sheet and an annotated sheet showing changes.

Remarks/Arguments begin on page 5 of this paper.

An **Appendix** including amended drawing figures is attached following page 5 of this paper.

Amendments to the Specification:

Please replace paragraph [0021] with the following amended paragraph:

[0021] In the construction of the bucket of this invention, various materials have been selected ~~[[and]]~~ which offer a number of diverse properties ~~[[,]]~~ and allow for varied functions of the article. For caustic solutions, the bucket can be made of a durable ~~polymer~~ plastic material. Where an aesthetic appeal is desired, the bucket can be any ~~[[of]]~~ one of many attractive colors. The following ~~listing~~ list of properties serves to define possible uses for the buckets.

Please replace paragraph [0045] with the following amended paragraph:

[0045] Figure 1 displays a bucket of the invention. As can be seen from the drawing, ~~the~~ a handle is attached to the upper lip of the structure and connected at points diametrically opposite each other on the circumference.

Please add the following new paragraph after paragraph [0075]:

[0075.1] An optional feature of the articles of the invention is the addition of a tetrafluoroethylene coating to the bucket to provide protection from any contents which might be caustic. The coating can be provided to the surface during the manufacturing process or can be added in a later step.

Please delete the paragraph beginning at page 2, line 4, which starts with "Under normal circumstances"

16 of 20

Appl. No. XX/YYYY,YYY

Amdt. dated Jan. 15, 2004

Reply to Office action of Oct. 16, 2003

Amendments to the Claims:

This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims:

Claims 1-5 (canceled)

Claim 6 (previously presented): A bucket with a handle.

Claim 7 (withdrawn): A handle comprising an elongated wire.

Claim 8 (withdrawn): The handle of claim 7 further comprising a plastic grip.

Claim 9 (currently amended): A bucket with a ~~green~~ blue handle.

Claim 10 (original): The bucket of claim 9 wherein the handle is made of wood.

Claim 11 (canceled)

Claim 12 (not entered)

Claim 13 (new): A bucket with plastic sides and bottom.

Amendments to the Drawings:

The attached sheet of drawings includes changes to Fig. 2. This sheet, which includes Fig. 1-2, replaces the original sheet including Fig. 1-2. In Figure 2, previously omitted element 13 has been added.

Attachment: Replacement Sheet
 Annotated Sheet Showing Changes

REMARKS/ARGUMENTS

In the specification, the paragraphs [0021] and [0045] have been amended to correct minor editorial problems. The new paragraph [0075.1] added after paragraph [0075] discusses in general terms the features taken from Example 4.

In amended Figure 2, the previously omitted element numeral 13 has been added.

Claims 6-10 and 12-13 remain in this application. Claims 1-5 and 11 have been canceled. Claims 7 and 8 have been withdrawn.

The examiner has acknowledged that claims 6 and 9-10 are directed to allowable subject matter. Claim 7-8 have been withdrawn as the result of an earlier restriction requirement. Claim 13 adds an additional feature from Example 2 in the specification.

In view of the examiner's earlier restriction requirement, applicant retains the right to present claims 7-8 in a divisional application

.....

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

SMITH, JONES & BROWN

By _____
Martin J. Gallagher
Reg. No. 99,999
Tel.: (101) 555-2345

Attachments

